



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,078	03/05/2002	Herbert Cooper	F-7885	6721

7590 04/04/2003

LERNER AND GREENBERG, P.A.
POST OFFICE BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/091,078

Applicant(s)

COOPER, HERBERT

Examiner

Bret C Hayes

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim-Rejections-35-USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 20 recites the limitation "said gimble tube" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 4, 6, 8 – 10, 15 – 20 and 25 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,140,9285 to Frick.
6. Regarding claim 1, Frick discloses a fishing system to be mounted to a boat, the system comprising: a housing **32**; a mast **14**, having a mast axis, disposed on the housing **32**; a first actuator **78** connected to and rotating the mast **14**, about the mast axis, and a second actuator **52** connected to and pivoting the mast **14**. Frick discloses the claimed invention except for the mast being disposed in the housing and the second actuator pivoting the housing. It would have been

Art Unit: 3644

obvious to one having ordinary skill in the art at the time the invention was made to locate the mast within the housing and pivot the entire housing instead of solely the mast, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

7. Regarding claim 2, Frick discloses the system including a holding plate **60**.

8. Regarding claim 3, Frick discloses the claimed invention except for the holding plate having bearing journals and support trunions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use bearing journals and support trunions, since it was known in the art that journals assist in rotational components and trunions assist in supporting structures.

9. Regarding claim 4, Frick discloses the second actuator **52** being coupled to the holding plate **60**.

10. Regarding claim 6, Frick discloses the claimed invention except for the mast **14** being made of carbon fiber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the mast from carbon fiber, since it has been held to be within the general skill of a worker in the art to select a known material, which carbon fiber is, on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Carbon fiber fishing poles are well known and would clearly lead one of ordinary skill in the art to use carbon fiber in a fishing mast.

11. Regarding claim 9, Frick discloses the actuators being electro-hydraulic.

12. Regarding claim 10, Frick discloses a base part **38** rotatably connected to the mast **14**.

Art Unit: 3644

13. Regarding claim 15, Frick discloses the claimed invention except for a clamp. Frick

discloses retaining means, which can be any art recognized equivalent, to include a clamp.

14. Regarding claims 16 – 18, Frick discloses the claimed invention, including the holding plate 60 having an opening and the structure of the mast and actuators projecting therethrough, except for a flexible-material cover surrounding the housing above the opening. This device is commonly known as a boot or sheath and is designed to protect certain structures from the elements and is well known in any environment where the elements need protection. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a boot or sheath in order to protect the actuators and other moving parts from the elements.

15. Regarding claim 20, Frick discloses the claimed invention except for a second clasp arm connected to and supported by a gimble tube. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the second clasp arm to the gimble tube, which is, essentially, the base of the mast, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

16. Regarding claim 25, see paragraphs 6 and 10 above.

17. Regarding claim 26, Frick discloses the claimed invention. Frick discloses a female connector 46 wherein a T-bar end 48 is fitted to provide a pivot, col. 5, lines 16 – 18. While Frick does not explicitly state the existence of a pin within the T-bar end, Frick does show a nut, presumably fastened to an end of a bolt or screw, which would constitute a pin. Therefore, it

Art Unit: 3644

would have been obvious to one having ordinary skill in the art at the time the invention was made to include a pin releasably holding the mast to the base part.

18. Regarding claims 27 and 28, Frick discloses the invention substantially as claimed except for the variety of rigidity in the materials selected for the mast and the adjustability of the mast. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use carbon fiber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the mast to give optimal adjustability, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

19. Claims 7 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Frick in view of US Patent No. 5,445,102 to Rupp. Frick discloses the invention substantially as claimed. See paragraph 3 above. However, Frick does not disclose the mast being formed of three parts telescopically connected. Rupp teaches telescopically connecting members in the same field of endeavor for the purpose of connecting outrigger members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to telescopically connect the mast members in order to allow extending, retracting and pivoting of the mast. Further, Frick discloses the claimed invention except for the mast being formed in three parts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the mast of any number of parts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*,

Art Unit: 3644

193 USPQ 8. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the telescopic mast pieces position themselves together in any number of desirous configurations, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

20. Regarding claim 19, Frick in view of Rupp discloses the claimed invention except for at least two eyelets disposed on the mast for guiding a line, rope or wire. It would have been obvious to one having ordinary skill in the art at the time the invention was made to dispose at least two eyelets on a mast for guiding a line, rope or wire, since it was well known in the fishing art that eyelets are disposed on fishing poles for the same purpose.

21. Claims 5, 11 – 14 and 21 – 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Frick in view of Cooper et al.

22. Regarding claim 5, Frick discloses the invention substantially as claimed, as applied to claim 2 above. However, Frick does not disclose a locking mechanism for securing the mast, the mechanism being attached to the boat, and the mast having a clasping mechanism engaged and secured by the locking mechanism.

23. Cooper et al. teach a locking mechanism 3 for securing the mast 5, the mechanism 3 being attached to the boat 1, and the mast 5 having a clasping mechanism 7 engaged and secured by the locking mechanism 3 in the same field of endeavor for the purpose of securing a mast to a boat in an upright position.

24. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Frick to include the locking mechanism as taught by Cooper et al. in order to secure a mast to a boat in an upright position.

25. Regarding claims 11 – 14, Frick in view of Cooper et al. discloses the invention substantially as claimed, as applied to claim 5 above. However, Frick in view of Cooper et al.

does not disclose a third actuator with a pin mounted on the base for pivoting the pivotable body to disengage the locking mechanism from the clasp mechanism.

26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the actuator setup, since it has been held that broadly providing a mechanical or automatic means to replace manual activity, which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

27. Regarding claims 21 – 24, Frick in view of Cooper et al. discloses the invention as claimed, as applied to claims 5 and 11 – 14 above.

Allowable Subject Matter

28. The indicated allowability of claims 5, 8, 11 – 14, 16 – 24 and 26 – 28 is withdrawn in view of the newly discovered reference(s) to Cooper et al. Rejections based on the newly cited reference(s) are contained in the body of the Action above.

Response to Arguments

Applicant's arguments filed 29 January 2003 have been fully considered but they are not persuasive. Regarding the claimed structural differences of Frick not rotating the mast, Frick discloses actuator 78, which rotates the inner disk, which, in turn, rotates the mast. As indicated above, to rearrange the essential working parts would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. Further, in response to Applicant's arguments that claims 2 – 4 are not taught by Frick, it has been held that

Art Unit: 3644

the test for obviousness is not whether the features of one reference may be bodily incorporated

~~into the other to produce the claimed subject matter but simply what the combination of~~

references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ

545 (CCPA 1969). In this case, to add to and rearrange the parts of Frick to create the same

invention, functionally, would have been obvious to one having ordinary skill in the art at the

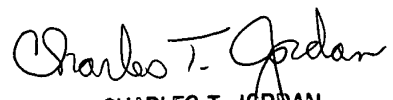
time the invention was made.

29. Regarding the argument that carbon fiber is not taught in the prior art, Examiner supplies US Patent No. 4,043,074 to Airhart as evidence that it was known in the fishing art for more than 20 years, to make a fishing rod, or, in this case, a mast, of carbon fiber and that structurally the differences between rods and masts is small and would be obvious to one having ordinary skill in the fishing art.

Conclusion

30. Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306-0553. The examiner can normally be reached Monday through Friday from 7:00 am to 4:30 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306-4159. The fax number for this group is (703) 305-7687.


CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

bh

4/1/03